

REMARKS

Upon entry of this Response, claims 1-20 remain pending in the present application. Applicant requests reconsideration of the pending claims in view of the following remarks.

In item 3 of the Office Action, the drawings have been objected to because of an error noted in FIG. 8. A replacement sheet is attached hereto that corrects the error to FIG. 8. Accordingly, Applicant requests that the objections to the drawings be withdrawn.

In item 4 of the Office Action, the drawings have been objected to because of an alleged error. Specifically, the Office Action noted that "103b" on page 10, line 27 of the specification did not appear in the drawings. Upon closer scrutiny, Applicant has determined that the "103b" on page 10, line 27 should actually be "203b" in accordance with FIG. 3. Accordingly, the specification has been amended above to correct this inadvertent error. Applicant requests that the objection to the drawings in this respect be withdrawn.

Next in item 5 of the Office Action, the specification has been objected to for the errors noted. Specifically, on page 9, line 5, the update list 173 appears, where the references number 173 is directed toward a "form profile". An appropriate correction to the specification is made above that changes the "173" to "176". Also, the Office Action notes an error in box 339 of FIG. 8 relative to the description of FIG. 8 in the specification. An appropriate amendment to FIG. 8 addresses this objection to the specification as described above. Accordingly, Applicant requests that all objections to the specification be withdrawn.

Next, in item 7 of the Office Action, claims 1-3, 7-8, 12, 15-16 and 20 have been rejected under 35 U.S.C. §102e as being anticipated by U.S. Patent 6,253,216 B1 issued to Sutcliffe et al. (hereafter "Sutcliffe"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow, Applicant asserts that Sutcliffe fails to show or suggest each of the elements of claims 1-3, 7-8, 12, 15-16, and 20. Accordingly, Applicant requests that the rejection of these claims be withdrawn.

To begin, claim 1 provides as follows:

1. A method for filling out a form, comprising the steps of:
 - maintaining a database in a server that includes a form profile having a number of data fields, the form profile being associated with a user;
 - maintaining a form template in the server, the form template including a list that comprises a subset of data fields in the form profile;
 - defining a form that includes a data entry from each of the data fields in the form profile that are included in the list in the template; and
 - transmitting the form to a client in response to a request from the client.

With respect to claim 1, the Office Action states:

"Regarding independent claim 1, Sutcliffe discloses a form that has been filled out in Figure 4A at reference sign 188. Sutcliffe also recites: "*The personals-on-line network includes at least one server computer which can be accessed by the remote users. The local computer network also has at least one computer software program and at least one database located therein*" (column 2, lines 35-39) and "*In accordance with the present invention, a system for generating a page for display on a computer system accessible to a plurality of remote users through a computer network includes means for displaying at a user site at least one template, means for inputting user-data to be included in a predetermined area of the template, means for storing the user-data in a predetermined field of a database and means for retrieving the user-data from the database and for displaying the template and the user-data on a display of the computer system*" (column 2, lines 21-31)." (Office Action, pages 4-5).

Applicant respectfully disagrees. Specifically, at column 2, lines 21-39, Sutcliffe states as follows:

"In accordance with the present invention, a system for generating a page for display on a computer system accessible to a plurality of remote users through a computer network includes means for displaying at a user site at least one template, means for inputting user-data to be included in a predetermined area of the template, means for storing the user-data in a predetermined field of a database and means for retrieving the user-data from the database and for displaying the template and the user-data on a display of the computer system. In one embodiment, the system may used to provide a personals page for use in a personals-on-line network. In this embodiment, remote users may connect to the personals-on-line network through a larger network, such as the Internet. The personals-on-line network includes at least one server computer which can be accessed by the remote users. The local computer network also has at least one computer software program and at least one database located therein."

Claim 1 specifies that both a form profile having a number of data fields and a form template are stored in a server. The form template includes a list that comprises a subset of the data fields in the form profile. In this respect, the form profile includes information about a user, where the form template specifies a subset of the information in the form profile. The subset of the information (subset of data fields) are all provided for a specific purpose such as medical information and the like.

In addition, claim 1 specifies that a form is defined that includes a data entry from each of the data fields in the form profile that are also included in the list in the template. In this respect, the list in the template dictates what information is to be taken from the form profile in order to generate a particular form. Thereafter, the form including such information is transmitted to a client upon the request.

Sutcliffe fails to show or suggest each of these elements. In particular, Sutcliffe is directed to an online "personals" system that provides individuals with an ability to create web pages to advertise themselves in a dating network. In this respect, users may access "templates" and enter their information into these templates to form their own "personal" web page. The personal web pages may then be presented to other users over the Internet for purposes of setting up introductions, etc. The "templates" discussed by Sutcliffe are empty web pages.

By contrast, claim 1 specifies that a form profile is stored in the server having a number of data fields and a form template that includes a list that comprises a subset of the data fields in the form profile. Nowhere does Sutcliffe show or suggest "templates" that include a list that comprises a subset of data fields in a form profile as claimed.

In addition, claim 1 sets forth defining the form that includes the data from each of the data fields in the form profile that are also listed in the template. In this respect, a form is created using information from the form profile as specified by the list associated with a given template. Nowhere does Sutcliffe suggest creating a form that includes data taken from a form profile that corresponds to the data fields listed in a given template. Accordingly, Applicant asserts that Sutcliffe fails to show or suggest each of the elements of claim 1. In addition, to the extent that claims 7 and 15 include subject matter similar in scope with that of claim 1, Applicant requests that the rejection of claims 7 and 15 be withdrawn. Also, Applicant respectfully requests that the rejection of claims 2, 3, 8, 12, 16, and 20 be withdrawn as depending from either claims 1, 7, or 15.

In addition, in item 15 of the Office Action, claims 4, 9-11, and 17-19 have been rejected under 35 U.S.C. §103a as being unpatentable over Sutcliffe in view of U.S. Patent Publication 2002/0091937 filed by Ortiz (hereafter “Ortiz”). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicant notes that claims 4, 9-11, and 17-19 depend from claims 1, 7, and 15. Accordingly, Applicant asserts that the rejection of claims 4, 9-11, and 17-19 is improper for the same reasons as was described above with respect to claims 1, 7, and 15. Therefore, Applicant respectfully requests that the rejection of claims 4, 9-11, and 17-19 be withdrawn.

In addition, in item 19 of the Office Action, claims 5-6 and 13-14 have been rejected under 35 U.S.C. §103a being unpatentable over Sutcliffe in view of U.S. Patent 5,563,998 issued to Yaksich (hereafter “Yaksich”). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicant asserts that the rejection of claims 5-6 and 13-14 is improper. Accordingly, Applicant requests that the rejection of claims 5-6 and 13-14 be withdrawn. To begin, claims 5 and 6 as originally filed state as follows:

5. The method of claim 3, further comprising the steps of:
identifying a form subject to an update due to the
updating of the form profile; and
transmitting an updated form to the client, wherein the
client previously received the form.

6. The method of claim 5, further comprising the step of
maintaining a list in the server of a number of clients to receive one of a
number of updated forms.

With respect to claims 5 and 6, the Office Action states:

“Regarding dependent claims 5 and 6, Sutcliffe discloses a form creation and transmitting method of personal information as described above. Sutcliffe further describes the updating of the form, but fails to disclose re-transmitting a form based upon information updates, or maintaining a list of clients to receive the updated form. Yaksich teaches the re-transmission of forms based upon updates and maintaining a list of receivers. Yaksich recites: “*According to the invention, the same form may be printed at a number of geographically*

remote locations on different types of printers, the form can be distributed and updated automatically and efficiently” (column 1, lines 49-52). Yaksich also discloses in Figure 13b at reference sign NCLP110 a list of clients (shown as “*Customers*”) maintained by the system.

Applicant respectfully disagrees. In particular, at column 1, lines 38-57, Yaksich states:

“According to the present invention, a detailed implementation is provided for a system and method which overcome the major elements of the problems identified above. According to the present invention, it is possible for a large consumer of forms, having numerous geographically remote user locations with varying needs for many different types of forms, to eliminate or minimize the warehousing, inventory, and obsolescence costs associated with the preprinted form, to minimize the number of preprinted forms utilized, to minimize redundant entry and processing of information, and to provide centralized design, control and management of electronic forms. According to the invention, the same form may be printed at a number of geographically remote locations on different types of printers, the forms can be distributed and updated automatically and efficiently, and if a form is needed but not readily reproducible on in house equipment, an order for the form may be transmitted to a vendor’s manufacturing facility or facilities (e.g. located geographically proximate the remote user locations to be served) for production and distribution.

As can be seen in the excerpt above, Yaksich describes the distribution of forms used by a business. Such forms are printed out of a number of geographically remote locations after being accessed by users on a network.

Claim 5, on the other hand, recites identifying a form subject to an update due to the updating of the form profile. In this respect, the form is not the same thing as the form profile as set forth in claim 1. Also, the updated form is transmitted to the client where the client previously received the form.

In addition, claim 6 recites maintaining a list in the server of a number of clients to receive one of a number of updated forms. With respect to this element, the Office Action points to Figure 3b reference sign NCLP110 in which the following is stated: “NCLP110 customer list/update”.

Applicant asserts that the citation to Figure 13b by the Office Action as describing the subject matter of either claims 5 or 6 is improper. For example claim 6 describes maintaining a list in the server of a number of clients to receive one of a number of updated forms. While the portion of Figure 13b states “customer

list/update", it does not show or suggest maintaining a list in the server of a number of clients that are to receive one of a number of updated forms, where such forms were updated due to an update in the form profile as set forth in claim 5 from which claim 6 depends.

Therefore, Applicant respectfully asserts that the rejection of claims 5 and 6 is improper. In addition, to the extent that claims 13 and 14 recite subject matter similar in scope with that of claims 5 and 6 above, Applicant asserts that the rejection of claims 13 and 14 is improper for the same reasons with respect to claims 5 and 6. Accordingly, Applicant requests that the rejection of claims 5, 6, 13, and 14 be withdrawn.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,



Michael J. D'Aurelio
Reg. No. 40,977

D'Aurelio & Mathews, LLC
96 Church Street
Chagrin Falls, Ohio 44022
Phone: (440) 729-7450
Fax: (440) 729-7465